

**REMARKS**

Claims 29-54 are pending in the application.

Claims 51-54 are rejected.

Claims 29-50 are withdrawn.

Claim 51 is amended.

Reconsideration and allowance of claims 51-54 is respectfully requested in view of the following:

***Claim Rejections – 35 U.S.C. §112***

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for use of the term "high enough." Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for use of the phrase "an additional shipping fee." Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for use of the term "separable." These rejections are overcome in view of the amendments to claim 51.

***Responses to Rejections to Claims – 35 U.S.C. §103***

Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaka (U.S. Patent No. 5,628,054) (Osaka) and in view of Rasmussen et al (U.S. Publication No. 2003/0167244) (Rasmussen), as evidenced by K. Fred Wehmeyer, "THINLINE® Portable Energy Products A New Approach To Sealed Lead Battery Technology" (Wehmeyer). This rejection is not applicable to the amended claims.

Claim 51 includes: a chassis; a battery bay defined by the chassis; and a battery assembly being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically mated and electrically coupled together to form the battery assembly, the plurality of battery subassemblies comprising: a first subassembly having a mating surface including a first pattern for mating engagement with a second subassembly having a mating surface including a second pattern, which is an inverse pattern to the first pattern, to resist relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly.

The claimed combination is unique and is not shown nor suggested by the references either singly or combined.

The amendments to claim 51 are fully supported by the application as filed, see par. [0021] for example.

The references do not teach or suggest a chassis; a battery bay defined by the chassis; and a battery assembly being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically mated and electrically coupled together to form the battery assembly, the plurality of battery subassemblies comprising: a first subassembly having a mating surface including a first pattern for mating engagement with a second subassembly having a mating surface including a second pattern, which is an inverse pattern to the first pattern, to resist relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains... (emphasis added).

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach a chassis; a battery bay defined by the chassis; and a battery assembly being removed from the battery bay during shipping to a user and being inserted in the battery bay after receipt by the user to avoid increased shipping fees, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically mated and electrically coupled together to form the battery assembly, the plurality of battery subassemblies comprising: a first subassembly having a mating surface including a first pattern for mating engagement with a second subassembly having a mating surface including a second pattern, which is an inverse pattern to the first pattern, to resist relative movement between the first and second subassemblies when the mating surfaces are engaged to form the battery assembly.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

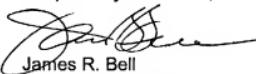
Therefore, independent claim 51 and its respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 51-54 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



James R. Bell

Registration No. 26,528

Dated: 2-28-08  
Haynes and Boone, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 512.867.8407  
Facsimile: 214.200.0853  
ipdocketing@haynesboone.com

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office, via EFS-Web, on the date indicated below:

on

February 28, 2008



Susan C. Lien